

### **REMARKS**

The applicants have carefully considered the Office action dated October 19, 2005 and the references it cites. By way of this Response, claims 13, 33, 35, 61, 62, 66, 79, 80 and 84 have been amended, new claims 88-103 have been added, and claims 1-12, 22-27, 40-56, and 70-78 have been cancelled without prejudice to their further prosecution. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

Turning first to the objections to the specification and drawings, the applicants note that the abstract has been made more generic and Fig. 1 has been amended to correct the typographical error noted in the Office action. Therefore, the objections to the figures and specification should be withdrawn.

With respect to the objection to claim 61, the first and second means were not the same limitation prior to amendment. Nevertheless, the claim has been amended and this objection is moot.

Turning to the art rejections, the Office action rejected original claims 13-39, 61-69 and 79-87 as being unpatentable over one or more of *Aras*, U.S. Patent 5,872,588, applicant's own *Houston*, U.S. Patent 6,353,929, *Hendricks et al.*, U.S. Patent 6,738,978, and *Ellis et al.*, U.S. Patent 5,436,653. The applicants respectfully traverse these rejections.

Independent claim 13 recites a television audience measurement system for digital television equipment comprising, among other things, a software agent adapted to read a program identification (PID) header from a data packet containing a portion of a tuned digital television program to identify the television program tuned by the digital television equipment,

wherein the PID header is broadcast with the data packet to enable the digital equipment to tune to a selected one of a plurality of minor channels broadcast in a major channel. None of the cited art teaches or suggests such a method.

***The U.S. Patent & Trademark Office has already concluded that Aras does not teach or suggest logging PIDs*** as recited in claim 13. In particular, the parent of this application, namely, US patent application serial number 09/076,517 (the “parent application”) includes claims which were copied in an effort to provoke an interference with Massetti, U.S. Patent 5,974,299 (the “‘299 Patent”). By way of background, the applicant for the ‘299 Patent, Enrico Massetti, is a former employee of Nielsen Media Research, the assignee of the instant application. Days after his working relationship with Nielsen Media Research came to a close, Mr. Massetti filed the patent application which later matured into the ‘299 Patent. However, on March 12, 1998, fifteen days before Mr. Massetti filed his patent application, the applicants filed the parent application. After learning of the ‘299 Patent, the applicants copied claims of the ‘299 Patent into the parent application in an effort to provoke an interference.

Examiner Christopher Grant, the very same examiner who examined and allowed the ‘299 Patent, rejected the copied claims as unpatentable over Aras et al, U.S. Patent 5,872,588, in the parent to this application. This was a surprising turn of events because the parent application has an earlier filing date than the ‘299 Patent and the Aras et al. reference was considered by Examiner Grant during the proceedings which led to the issuance of the ‘299 Patent. Since Examiner Grant found the copied Massetti claims patentable over Aras et al. in the context of the ‘299 Patent, logical consistency

demanded that those same claims would be patentable over Aras et al. in applicants' earlier filed application; unless, of course, the USPTO acted in error in allowing the '299 Patent.

In view of the USPTO's inconsistency, the applicants for the parent application responded by traversing the rejections. In response, Examiner Grant sustained his rejections based on Aras et al. and implicitly invited the applicants to file a request for reexamination. Therefore, the applicants filed a request for reexamination of the '299 Patent based on the Aras patent and other references.

In the reexamination of the '299 Patent (Control No. 90/007,057), the USPTO recently issued a notice of allowance stating:

Aras fails to teach or suggest recording the PID ... along with the time [of] reception, in that Aras teaches recording the payload data of the PID, and which has more information than the PID alone. ***Consequently, there is no motivation to store the PID information of Aras in that the Aras system already has similar information (derived from the payload portion but not the PID per se).***

(Control No. 90/007,057, Notice of Intent to Issue Ex Parte Reexamination Certificate dated April 3, 2006, Statement of Reasons for Patentability and/or Confirmation, Pages 12-13)(emphasis added). Therefore, the USPTO has already concluded that Aras does not teach or suggest a software agent adapted to read a program identification (PID) header to identify a television program tuned by digital television equipment as recited in claim 13. On the contrary, as noted by the USPTO in its earlier decision, "Aras teaches recording the payload data of the PID." (Id.) Because the payload data "has

more information than the PID alone,” the USPTO has concluded that “***there is no motivation to store the PID information of Aras.***” (Id.)

Furthermore, the Aras patent clearly contemplates actively encoding broadcast content by inserting program identification codes (referred to in Aras as AVIs) into the content and collecting the inserted codes at the reception site. (See Aras, col. 7, lines 5-58). It is indisputable that these inserted AVI codes are not PID headers. As recited in claim 13, the PID header is broadcast with the data packet to enable the digital equipment to tune to a selected one of a plurality of minor channels broadcast in a major channel. The AVIs of Aras are clearly not involved in tuning, but instead are inserted precisely for the purpose of audience measurement. (See, Aras, Col. 7, lines 34-35 indicating that the AVIs may be inserted at intervals in the content, thereby implicitly indicating that they are not involved in tuning like the PID headers that accompany every packet of a digital broadcast).

This distinction is important. Whereas Aras requires active encoding and, thus, cooperation of broadcasters to ensure that broadcast programs tuned at a monitored site are properly identified, claim 13 does not require broadcaster cooperation. Instead, claim 13 relies upon an inherent portion of a digital broadcast stream, namely, the PID header, as a vehicle for identifying the tuned program. Aras provides no suggestion of the approach of claim 13 or its advantages. Accordingly, the rejection of claim 13 based on Aras are in error and must be withdrawn.

None of the other cited art overcomes the deficiencies of Aras. As noted in the prior USPTO decision quoted above, there is no motivation to

modify Aras to store PIDs. Accordingly, claim 13 and all claims depending therefrom are in condition for allowance.

Independent claim 61 is also allowable. Claim 61 provides a software agent including first logging means for logging a television program identification (PID) header from a data packet containing a portion of a tuned television program to identify the television program selected for viewing on digital television equipment. As discussed above, nether Aras nor any other reference of record taken alone or in combination with Aras teaches or suggests a logging means to log PID headers. Accordingly, claim 61 and all claims depending therefrom are in condition for allowance.

Independent claim 62 is also in condition for allowance. Claim 62 recites an apparatus for identifying a viewer selected television program received by digital television program reception equipment which has a data port to export tuned data. The apparatus comprises, among other things, reading means connected to the data port for reading program identifying data tuned by the digital television program reception equipment from among data exported from the digital television program reception equipment via the data port. The rejection of claim 62 was based on a reading of “data port” as the reception/input port for receiving the television transmission at the digital television program reception equipment (see Office action, Page 6). However, the data port of claim 62 is not an input port for receiving television transmissions. It is a data port to export tuned data from the digital television program reception equipment. Thus, claim 62 specifies that the reading means is “connected to the data port for reading program identifying data *tuned by the digital television program reception equipment from among data **exported***”

*from the digital television program reception equipment via the data port.”*

There is no teaching or suggestion in Aras or any of the other art of record of such a reading means. Accordingly, claim 62 and all claims depending therefrom are in condition for allowance.

Independent claim 66 is also allowable. Claim 66 recites an apparatus for identifying a viewer selected television program received by digital television program reception equipment which has a data port to export tuned data. The apparatus comprises, among other things, reading means connected to the data port for reading program identifying data tuned by the digital television program reception equipment from among data exported from the digital television program reception equipment via the data port. As explained above in the discussion of claim 62, no combination of the art of record teaches or suggests such an apparatus. Accordingly, claim 66 and all claims depending therefrom are in condition for allowance.

Independent claim 79 is also allowable. Claim 79 recites a method to acquire audience measurement data relative to digital television equipment comprising, among other things, logging a television program identification (PID) header from a data packet containing a portion of a tuned digital television program to identify the television program selected for viewing on the digital television equipment. As discussed above, no combination of the cited art teaches or suggests such a method. Accordingly, claim 79 and all claims depending therefrom are in condition for allowance.

Independent claim 80 is also in condition or allowance. Claim 80 recites a method for identifying a viewer selected television program received by digital television program reception equipment which has a data port to

export tuned data. The method comprises, among other things, reading program identifying data tuned by the digital television program reception equipment from among data *exported* from the digital television program reception equipment via the data port. As discussed above, no combination of the cited art teaches or suggests such a method. Accordingly, claim 80 and all claims depending therefrom are in condition for allowance.

Independent claim 84 is also in condition or allowance. Claim 84 recites a method for identifying a viewer selected television program received by digital television program reception equipment which has a data port to export tuned data. The method comprises, among other things, reading program identifying data tuned by the digital television program reception equipment from among data *exported* from the digital television program reception equipment via the data port. As discussed above, no combination of the cited art teaches or suggests such a method. Accordingly, claim 84 and all claims depending therefrom are in condition for allowance.

Before closing, the applicants note that they expressly traverse the obviousness rejections made in the Office action as failing to properly identify legally cognizable suggestions for combining the references. For example, it is plainly improper to take “official notice” of a suggestion to combine references. Official notice is a mechanism available to examiners to identify facts that are unquestionably indisputable such that finding evidence to demonstrate those facts would be an unnecessary undertaking. Clearly, it can never be acceptable to provide no evidence for the suggestion requirement<sup>1</sup>.

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<sup>1</sup> See the quote from the In re Warner case on the following page.

Indeed, taking “official notice” of a suggestion is the epitome of hindsight reconstruction of the invention. Accordingly, applicants hereby traverse the official notices and request that the Examiner provide evidence in place of any official notice.

With respect to the other “suggestions” identified in the Office action, applicants expressly traverse the same as amounting to nothing more than an identification of an alleged benefit of making the proposed combination of references. In order to establish a prima facie case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Further, to establish a prima facie case of unpatentability, particular factual findings demonstrating the suggestion to combine must be made. See, for example, Ecolochem Inc. v. Southern California Edison, 56 U.S.P.Q.2d 1065, 1072-73 (Fed. Cir. 2000) and In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999). Indeed, the law is quite clear that an obviousness rejection must be based on facts, not conjecture.

The Supreme Court... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness *must be supported by facts*. Where the legal conclusion is not supported by facts it cannot stand.

In re Warner, 379 F.2d 1011, 1017 (C.C.P.A. 1967). An identification of an alleged benefit of combining two or more references imagined by the USPTO is not an identification of actual evidence of a suggestion, but rather is exactly



the sort of hindsight reconstruction the Courts of the United States have prohibited.

More specifically, since almost all inventions are a combination of old elements (see In re Rouffet, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998)), and since it is a statutory requirement that all inventions have utility, there will always be an identifiable end or advantage in combining the elements in the prior art in the manner recited by virtually any claim (e.g., if there was no purpose to an element in a claim it would not be included in the claim, after all, who would pursue a claim with superfluous elements or a claim with no utility?). Therefore, if the “suggestion” requirement of 35 U.S.C. § 103 can be met by merely imagining any end or advantage which will be achieved by combining the elements of the prior art references, the suggestion requirement can always be met and is utterly meaningless.

Therefore, the applicants respectfully traverse all of the 35 U.S.C. § 103 rejections as improper as a matter of law.

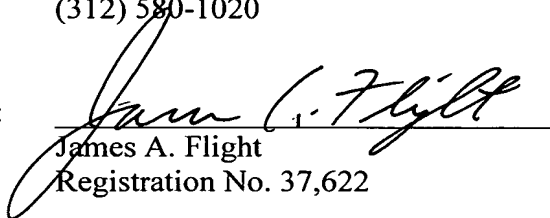
In view of the foregoing, it is respectfully submitted that all pending claims are in condition for allowance.

If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

Respectfully submitted,

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